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EXAMINER

PARKER, FREDERICK JOHN

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 07/08/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-6

Office Action Summary

Application No.

09/904,044

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 6/10/02
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-7 is/are pending in the application.
- Of the above claim(s) 1-4 is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 5-7 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/352,741.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of claims 5-7 in Paper No. 5 is acknowledged.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119 (a)-(d). The certified copy has been filed in parent Application No. 09/352,741, filed on 7/14/99.
3. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)).

Specification

4. The abstract of the disclosure is objected to because the meaning of line 2 is confusing because one or more words are missing. Correction is required. See MPEP § 608.01(b).
5. The disclosure is objected to because of the following informalities: On page 5, lines 3-5 and page 6, lines 1-2, the meaning of the brackets is unclear,

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and may be meant to be parentheses to show examples. Appropriate correction is required.

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The title is unduly long.

7. The use of the trademarks Chromabase and Basemaker have been noted in this application on page 6. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

8. Claim 5 is objected to because of the following informalities: The actual pigment formulation should be recited, rather than simply referring to claim 1; for examination, it will be assumed to be one comprising automotive paint and/or ink and a diluent mixed to a suitable ratio. Appropriate correction is required.

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Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 5: "primary and secondary viewpoints" lack proper antecedent basis; in step (c), "dense" is a relative term which does not clearly define the intended sponge, and the criteria for dense is not provided by the specification; the claim is vague and indefinite because the phrase "automotive paint or ink" which is inferred to be part of the formulation fails to clearly define the intended paint and/ or ink, and the specification fails to set forth the paint or ink by composition. For examination, the Examiner will consider any paint or ink capable of coating any portion of an automobile (metal, plastic, etc) to meet the limitation.

- Claims 6-7 are vague and indefinite because they are method claims which refer to formulation claim 3; for examination, the dependancy will be assumed to be to independent claim 5.

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Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neer US 5680893 in view of Thomas US 5518803.

Neer teaches that a woven or mesh fencing or screen product, preferably a substantially open weave pattern, may be coated with decorative patterns (sports emblems, scenic design, etc) to provide durable decorative coatings which withstand weathering, chipping, peeling and fading (col. 5, 1-3; col. 7,

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25+; col. 8, 33-40). The coating material, adjusted to sufficient viscosity for suitable flow, is a pigmented polymer-based coating material or paint which wets the substrate and is applied by mechanical means to spread the coating material on the substrate surface (col. 7, 35-41), although spraying, printing, and curtain coating are also cited. The ultimate product is such that the colors of the decoration cooperate such that one side is a reflective pattern while preventing transmitting images through the decorated product to allow privacy. Hence, "primary" and "secondary" viewpoints would have been determined in advance of applying the decoration. While use of diluent with the coating material is not explicitly cited, the need to adjust viscosity is recognized as discussed above, and it is the Examiner's position that one of ordinary skill would have recognized the obviousness of modifying viscosity by addition of fluid diluents. Tracing and free-hand roller application is not cited.

Thomas teaches applying decorative patterns to mesh materials by spraying ink or paint through a printing screen stencil. However, in column 1, lines 34-42, it was recognized that it is conventional to decorate mesh materials by "a free-hand approach". It is also recognized that it is known to apply paint to mesh materials using a brush or roller, as well as the use of stencils to apply a design. Hence, the overall teaches cited by the Examiner make it clear that the

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application of designs to mesh materials using stencils, rollers, and free-hand techniques were known in the art. Since Neer teaches the use of applying coatings by "mechanical means", there would have been the reasonable suggestion to apply such coatings using such application means, such as those disclosed by Thomas. It is the Examiner's position that since the paint of Neer will withstand weathering, chipping, peeling and fading, the paints are suitable for automotive applications as required by the claims. Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Neer by incorporating the conventional patterning means of Thomas because there would have been the expectation of successfully applying the polymer-based paints to a woven or mesh fencing or screen product.

14. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neer US5680893 in view of Thomas US 5518803 and further in view of Levy et al US 4,559,732.

The references are cited for the same reasons above. While the use of stencils to apply a design is discussed, tracing using a projected image is not taught.

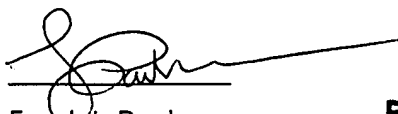
Levy et al teaches applying images to glass surfaces. Column 2, lines 55-64 teaches that images may be applied to a surface (paper in this case) by

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drawing or tracing of an image by overhead projector or the like which allows accurate tracing of the image or even enlargement of the image. Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Neer in view of Thomas by projecting the images as disclosed by Levy et al to the woven, mesh or screen substrate to form accurate or enlarged outlines of the desired decorative patterns.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. GB 2165292 teaches applying designs in half-tone dots to sports screens.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred J. Parker whose telephone number is (703) 308-3474.



Fred J. Parker

**FRED J. PARKER
PRIMARY EXAMINER**

July 8, 2002

9-352741